

REMARKS

Claims 1-6, 9-10, 12, 14, 15 and 17 are pending in the instant application. Claim 1 has been amended to further define the features of the invention. Specifically, Claim 1 has been amended to include the limitations of original claim 11 which has herein been canceled. Support for this amendment can be found throughout the specification and claims as originally filed. No new matter has been added.

Claims 6, 7 and 17 were previously withdrawn. Claim 7 has been canceled herein without prejudice. Thus Claims 6 and 17 remain withdrawn. As the Applicants believe the claims are presently in a condition for allowance, Applicants respectfully request rejoinder of claim 6 and method of use claim 17 in accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71, F.3d 1565 (Fed. Cir. 1995).

Applicants also note that the Examiner has stated that Claims 1-5 and 8-15 have been examined to the extent that they are readable on the elected embodiment, the compound of Example 7 and 1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine.

The Examiner also states that the Elected Species of Example 7 and is allowable but that the expanded scope is not for the reasons described below. As such, the Examiner has requested limitation to the Elected Species of Example 7. Applicants respectfully thank the Examiner for finding the Species of Example 7 allowable, but respectfully decline to limit the claims to such scope at this time.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the objections to and the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is believed to be in condition for allowance.

Rejections under 35 U.S.C. §102(b)

Claims 1-5, 12, 14 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,240,942 (“the ‘942 Patent”). Applicants respectfully disagree and traverse the rejection.

The Examiner alleges that the ‘942 Patent discloses 1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine. The Examiner specifically points to Example 29 which allegedly corresponds “to Applicants’ instant invention wherein R1 is a alkyloxy, specifically methoxy; X1-X5 are each CH; A is an alkylene, specifically methylene; n is 0; Cy is a heterocycloalkylene group, specifically pyrrolidine; m is 0 and R3 is B-Y wherein B is an alkylene, specifically methylene and Y is an aryl, specifically phenyl.”

As stated above, Claim 1 has been amended to include the limitations of original claim 11. Applicants note that Claim 11 was not rejected under §102(b) by the Examiner over the ‘942 Patent.

As neither Example 29 of the ‘942 Patent nor any of the compounds disclosed by the ‘942 Patent are encompassed by the amended claims, the ‘942 Patent can not anticipate the claimed invention.

As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be withdrawn.

Rejections under 35 U.S.C. §103(a)

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,240,942 (“the ‘942 Patent”). Applicants respectfully disagree and traverse the rejection.

As discussed above, the Examiner alleges that the ‘942 Patent discloses 1-benzyl-3-[(7-methoxynaphth-1-yl)methyl]pyrrolidine. The Examiner states that the difference between the claimed invention and the compound of example 29 is the position equivalent to A. The Examiner

contends that, absent a showing of unexpected or surprising results, it would have been obvious to prepare compounds of Claim 11, now incorporated into Claim 1, as one of ordinary skill in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which could be for the treatment of stress, migraines, anxiety and depression.

As an initial note, the '942 Patent relates to compounds which may be useful in the treatment of hypertension, migraine, depression, anxiety, schizophrenia, stress and pain. Nothing in the '942 Patent would suggest that the compounds of the '942 Patent could be used as antibacterial compounds. Indeed, one of ordinary skill in the art will readily appreciate that even small changes in the chemical structure of a compound can, and often do, result in very significant changes in the chemical properties of the compounds (steric, electrochemical, etc). As such, Applicants respectfully assert that one of ordinary skill in the art, at the time of the invention, would have lacked the motivation to modify the single methylene linker taught by the '942 Patent to arrive at the 2 or 3 chain length alkylene, alkenylene, alkynylene or heteroalkylene group of the instant invention without potentially sacrificing the purported properties of the compounds. Indeed, even if one were to have modified the compounds taught by the '942 Patent, there would have been no expectation of success in achieving the antibacterial properties of the instant compounds.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103

Furthermore, as Applicants have overcome the rejection of the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, Applicants again respectfully request the Examiner broaden the search scope to the extent necessary to determine patentability of the Markush-type claim and reexamine the Markush-type as described M.P.E.P §803.02. Furthermore, Applicants respectfully request the Examiner broaden the search in such a meaningful way so as to avoid further delay in allowance of the application.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections, and allowance of the instantly claimed invention is earnestly solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

PETITION FOR EXTENSION AND FEE AUTHORIZATION

Applicants request a three month extension for filing the within response. The Commissioner is hereby authorized to charge Deposit Account No. 04-1105 for the extension fee and for any additional fee(s) due with this response. Any overpayment should be credited to the noted Deposit Account.

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Respectfully submitted,

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